

**INTERVIEW SUMMARY**

On February 24, 2004, the undersigned attorney met with the Examiner to discuss the prior art cited in the Office Action, and to review the Examiner's rejections under 35 USC § 112, second paragraph. The Examiner and the undersigned attorney discussed the amendments listed above and possible additional information related to the product claims that are cancelled herein. A copy of the Applicant's Request for Interview and a copy of the Examiner's Interview Summary form are attached. The undersigned attorney thanks the Examiner for taking the time for the telephone interview.

**REMARKS**

The Examiner rejected claims 3, 8, 9, 23-27 and 29 under 35 U.S.C. 112 second paragraph, as indefinite. The Examiner has stated that the recitation of colors is potentially unclear. In the Interview summarized above, the undersigned attorney explained that a recitation of color is understood to one skilled in the art of the present invention for many reasons, including documents such as those submitted by the applicants in response to the Examiner's first Office Action and based on the atomic structure of diamonds. Applicants are cancelling claims 23-27 and 29 herein *without prejudice*, and reserve the right to present the same or similar claims in a continuing application. Applicants respectfully request consideration of the rejections of claims 3, 8 and 9 in view of the information discussed above.

The Examiner rejected claims 1 – 31 as unpatentable over *Strong et al.* (U.S. Patent No. 4,124,690) in view of *Wentorf, Jr.* (U.S. Patent No. 3,609,818). Applicants have amended claim 1 to clarify that the method changes the color of a brown diamond and results in a diamond having a different color. These limitations are found in dependent claim 30 (brown) and dependent claims 7 and 8 (color). Similarly, Applicants have amended claim 28 to clarify that the method changes the color of a brown diamond. This limitation is found in dependent claim 31. (Claim 28 already stated that the method results in a diamond having a color.) Neither *Strong et al.* nor *Wentorf, Jr.* disclose a method of changing the color of a diamond that starts with a brown diamond and results in a diamond having a different color. Rather, *Strong et al.* describes a method of making a yellow diamond pale or colorless while *Wentorf, Jr.* does not describe a color change at all. Applicants have withdrawn the product claims without prejudice. Accordingly, the Applicants respectfully request reconsideration of this rejection with respect to the claims remaining in this Amendment.

The Examiner rejected claims 1 – 31 as unpatentable over *Cannon*. (U.S. Patent No. 3,134,739) in view of the statement that repeating the process is obvious. As

described in the previous paragraph of these Remarks, Applicants have amended claims 1 and 28 to clarify that the method changes the color of a brown diamond and results in a diamond having a different color. These limitations are found in dependent claims 30 and 31 (brown) and dependent claims 7 and 8 (color). *Cannon* does not disclose a method of changing the color of a diamond that results in a diamond having a color. Further, to the extent that *Cannon* includes incidental disclosure of a method of changing the color of a brown diamond, Applicants note that (1) as stated in the previously-filed declaration of inventor Suresh Vagarali, the method disclosed in *Cannon* is not operable on brown diamonds, and (2) *Cannon* does not disclose a method that results in a diamond having a color. Accordingly, Applicants respectfully request reconsideration of this rejection with respect to the claims remaining in this Amendment.

The remaining claims are submitted to be allowable on the basis of the above remarks, and Applicants respectfully request prompt allowance

A copy of applicable assignment documents to Diamond Innovations, Inc., and a power of attorney to the undersigned attorney, are enclosed for the Examiner's reference. These documents are being formally recorded with the Assignment Division this week.

**CONCLUSION**

All of the stated grounds of objection and rejection have been properly traversed, accommodated or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding objections and rejections. There being no other rejections, Applicants respectfully request that the current application be allowed and passed to issue.

If the Examiner believes for any reason that personal communication will expedite prosecution of this application, I invite that the Examiner telephone me directly.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees, including any fees for net addition of claims, which may be required for this Amendment, or credit any overpayment to deposit account No. 50-0436. Applicants believe that no extension of time is necessary, however, in the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account No. 50-0436.

Respectfully submitted,

PEPPER HAMILTON LLP

A handwritten signature in black ink, appearing to read 'JMS', is written over the printed name 'James M. Singer'.

Registration No. 45, 111

Pepper Hamilton LLP  
50th Floor, One Mellon Center  
500 Grant Street  
Pittsburgh, PA 15219-2505  
Phone: 412-454-5000  
Facsimile: 412-281-0717  
Date: February 25, 2004



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
--------------------	-------------	-----------------------	---------------------

10/269362



EXAMINER
----------

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED:

INTERVIEW SUMMARY

All participants (applicant, applicant's representative, PTO personnel):

(1) Exr. Herdickson (3) \_\_\_\_\_

(2) Mr. Singer (4) \_\_\_\_\_

Date of Interview 2/24/04

Type: ☐ Telephonic ☒ Personal (copy is given to ☐ applicant ☒ applicant's representative).

Exhibit shown or demonstration conducted: ☒ Yes ☐ No If yes, brief description: slide show + summary of diamond types

Agreement ☐ was reached. ☒ was not reached.

Claim(s) discussed: all

Identification of prior art discussed: all applied

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: Treating 'brownish' diamonds as main thrust of invention. Declaration versus product of below book suggested.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☐ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary. A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has been ready been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

Examiner Note: You must sign this form unless it is an attachment to another form.

*Stefan*

FORM PTOL-413 (REV.1-96)